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3711

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q45980

Hisashi YAMAGISHI, et al.

Appn. No.: 08/898,853

Group Art Unit: 3711

Confirmation No.: 6473

Examiner: Raeann Gorden

Filed: July 25, 1997

For: MULTI-PIECE SOLID GOLF BALL

Submission of New Request for Interference

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action as mailed on November 6, 2006, Applicants submit the attached New Request for Interference. In order to facilitate the Examiner's review of the New Request for Interference, Applicants set forth herein answers to (and comments on) the Examiner's position as set forth in the November 6 Office Action.

(1) The Examiner asserts that Applicants have failed to provide sufficient information to identify the application or patent with which the Applicant seeks an interference. Office Action at page 2, lines 3-5.

Applicants note that this information was set forth on page 1 of the Renewed Request for Interference (hereinafter "RRFI") as submitted on April 21, 2006, under the heading "§41.202(a)(1) - Information Identifying the Patent for Interference". In that section, Applicants identify that they seek interference with US Patent 5,743,816, issued to Ohsumi et al., on April 28, 1998, from US Patent Application Serial No. 08/835,023, filed on March 27, 1997. This

information has been moved to page 2 of the New Request for Interference (hereinafter “NRI”), under the same section heading.

(2) The Examiner requests clarification of the count for the interference. Office Action at page 2, lines 6-18.

In the RRFI, Applicants identified the proposed counts as any one of claims 1-7 of the Ohsumi patent, or claims 13-19 of the Yamagishi Application. By this statement, Applicants were proposing that each claim defined a separate count, and that because the counts correspond to the claims of the Ohsumi patent, they are *prima facie* distinct. Nonetheless, to facilitate and simplify matters, Applicants now choose the alternative proposed by the Examiner; namely the broadest patentable claim between the parties. Thus, in the NRI section II entitled “§41.202(a)(2) - Proposed Count for the Interference” has been modified to reflect this change, wherein the count is claim 1 of the Ohsumi patent (which is identical to claim 13 of the Yamagishi Application). Further, this section has been modified so as to set forth a detailed explanation of how the subject matter of claims 14-19 of the Yamagishi Application, and claims 2-7 of the Ohsumi patent, are rendered obvious by the count (and thus correspond to the count) when taken in view of the various prior art references.

(3) The Examiner requests that Applicants more clearly identify how the claims correspond to the count. Office Action at page 2, line 19 - page 3, line 15. As noted above in item (2), in section II Applicants have more clearly identified how the claims are rendered obvious by the count and, therefore, correspond to the count.

(4) The Examiner requests that Applicants identify support for the claimed subject matter in parent application 08/661,778. Office Action at page 3, line 16 - page 4, line 10. Applicants note that the present application is a Rule 60 Continuation of parent application 08/661,778, wherein a “true copy” of parent application 08/661,778 was filed as the specification of the present application. Thus, support for the presently claimed subject matter can be found in parent application 08/661,778 on the identical page and line numbers as identified for the present

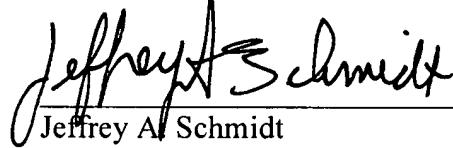
application. Such was set forth in the RRFI at page 7, 3rd paragraph. Nonetheless, to facilitate the Examiner's review, Applicants have added a column to the chart in Appendix B showing support for the claimed subject matter in parent application 08/661,778.

(5) Although not specifically requested by the Examiner, the claim chart in Appendix A of the NRI has been modified to include a column explaining how the claimed subject matter of the Yamagishi Application interferes with that in the Ohsumi patent within the meaning of 37 C.F.R. § 41.202(a)(3).

Conclusion

The Examiner is invited to contact the undersigned at his Washington telephone number on any questions which might arise.

Respectfully submitted,



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WASHINGTON OFFICE
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Date: December 6, 2006



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HISASHI YAMAGISHI et al

Application No.: **08/898,853**

Group Art Unit: **3711**

Filed: **July 25, 1997**

Examiner: **Raeann Gorden**

For: **MULTI-PIECE SOLID GOLF BALL**

**NEW REQUEST FOR INTERFERENCE PURSUANT TO
37 C.F.R. § 41.202 WITH U.S. PATENT 5,743,816**

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

Applicants request an Interference pursuant to 37 C.F.R. § 41.202, with US Patent 5,743,816, as set forth in the attached pages.

NEW REQUEST FOR INTERFERENCE PURSUANT TO 37 C.F.R. § 41.202
WITH U.S. PATENT 5,743,816
U.S. Application No. 08/898,853

Atty. Docket: Q45980

I. § 41.202(a)(1) - Information Identifying the Patent for Interference

Pursuant to 37 C.F.R. § 41.202, Applicants (hereinafter "Yamagishi et al.") hereby request that an Interference be declared between the above-identified application (hereinafter the "Yamagishi Application") and U.S. Patent 5,743,816, issued to Ohsumi et al., on April 28, 1998, from U.S. Patent Application Serial No. 08/835,023, filed March 27, 1997 (hereinafter the "Ohsumi patent").^{1/}

The remaining requirements of 37 C.F.R. § 41.202 are met as set forth below.

II. § 41.202(a)(2) - Interfering Claims / Proposed Count / Claim Correspondence

Interfering Claims

Applicants believe that claims 13-19 of the Yamagishi Application interfere respectively with claims 1-7 of the Ohsumi patent. Appendix A sets forth how claims 13-19 of the Yamagishi Application interfere with claims 1-7 of the Ohsumi patent.

Claims 13-19 of the Yamagishi Application were added by an amendment filed on April 27, 1999, which is less than one year after the issuance of the Ohsumi Patent (April 28, 1998).

^{1/} A copy of the Ohsumi Patent was provided to the Examiner along with the "Amendment under 37 C.F.R. § 1.116", filed April 27, 1999.

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Proposed Count

(Claim 1 of the Ohsumi Patent, which is also Claim 13 of the Yamagishi Application)

A solid golf ball comprising a solid core having a three-layered structure composed of an inner layer, an intermediate layer formed outside said inner layer, and an outer layer formed outside said intermediate layer, and a cover for coating said solid core, wherein:

 said inner layer is designed to have a Shore D hardness which is lower than that of said intermediate layer;

 said intermediate layer is designed to have a Shore D hardness of 45 to 65; and

 said outer layer is designed to have a Shore D hardness which is lower than that of said intermediate layer.

Claim Correspondence to the Count

As set forth in §41.207(b)(2), a claim corresponds to a count if the subject matter of the count, treated as prior art to the claim, would have anticipated or rendered obvious the subject matter of the claim. The claims correspond to the count as follows:

Claim 1 of the Ohsumi patent and claim 13 of the Yamagishi Application correspond to the count, because they are identical to the count.

Claims 2-7 of the Ohsumi patent, as well as claims 14-19 of the Yamagishi application, are rendered obvious by the count when taken in view of the prior art. The determination of obviousness under §103(a) is made according to the factual inquires set forth in *Graham v. John Deere Co.*, 838 U.S. 1, 148 USPQ 459 (1966) (See, also, MPEP §2141) as follows:

(A) Determine the scope and contents of the prior art;

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- (B) Ascertain the differences between the prior art and the claims in issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate evidence of secondary considerations.

In the present case, factors (A) and (C) are readily determined by a review of the prior art including the following US patents, relied on further below:

USP 5,688,191 to Cavallaro et al. (hereinafter Cavallaro), issued on November 18, 1997, filed on June 7, 1995, before the filing date (March 27, 1997) of the Ohsumi patent, and thus qualifies as prior art under 35 U.S.C. § 102(e);

USP 5,273,286 to Sun (hereinafter Sun), issued on December 28, 1993, more than one year prior to the filing date (March 27, 1997) of the Ohsumi patent, and thus qualifies as prior art under 35 U.S.C. § 102(b);

USP 5,253,871 to Viollaz (hereinafter Viollaz), issued on October 19, 1993, more than one year prior to the filing date (March 27, 1997) of the Ohsumi patent, and thus qualifies as prior art under 35 U.S.C. § 102(b);

USP 5,184,828 to Kim et al. (hereinafter Kim), issued on February 9, 1993, more than one year prior to the filing date (March 27, 1997) of the Ohsumi patent, and thus qualifies as prior art under 35 U.S.C. § 102(b);

USP 4,625,964 to Yamada (hereinafter Yamada), issued on December 2, 1986, more than one year prior to the filing date (March 27, 1997) of the Ohsumi patent, and thus qualifies as prior art under 35 U.S.C. § 102(b); and

USP 4,431,193 to Nesbitt (hereinafter Nesbitt), issued on February 14, 1984, more than one year prior to the filing date (March 27, 1997) of the Ohsumi patent, and thus qualifies as prior art under 35 U.S.C. § 102(b).

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With respect to (D), the Ohsumi patent was allowed on first office action, without any rejection, argument, or presentation of secondary considerations. Accordingly, no secondary considerations are believed to be pertinent in the present case.

With respect to (B), each of the claims 2-7 of the Ohsumi patent, as well as claims 14-19 of the Yamagishi application, are analyzed in further detail below.

Claim 2 of the Ohsumi patent (claim 14 of the Yamagishi Application) is rendered obvious by the count when taken in view of any one of Cavallaro, Viollaz, or Kim.

The count discloses everything therein except for an inner layer having a Shore D hardness of 20 to 40.

Cavallaro teaches that the core in a multilayer golf ball has a Shore D hardness of about 30 to about 65. See, for example, col. 8, lines 30-32. Viollaz teaches that the core in a multilayer golf ball has a Shore D hardness of between 40 and 50. See, for example, col. 2, lines 43-48. Kim teaches that the core in a multilayer golf ball has a Shore D hardness of 30-62. See, for example, the abstract. Further, Kim teaches that if the Shore D hardness of the core is less than 30, the core is too soft to give rebound characteristics necessary for reaching near the initial velocity limitation of 250 ft/sec set in USGA and R & A rules. Kim at col. 2, lines 50-57.

The low end-point of the ranges in each one of Cavallaro, Viollaz, and Kim, falls within the Shore D hardness range of claim 2 in the Ohsumi patent (claim 14 of the Yamagishi Application). Moreover, the “core” in each one of Cavallaro, Viollaz, and Kim, corresponds to the “inner layer” in claim 2 of the Ohsumi patent (claim 14 of the Yamagishi Application).

One of ordinary skill in the art would have been motivated to modify the count so as to include an inner layer having a Shore D hardness of 30 or 40 so as to provide a core having sufficient rebound characteristics to reach near the initial velocity limitation of 250 ft/sec, as taught by the prior art.

Claim 3 of the Ohsumi patent (claim 15 of the Yamagishi Application) is rendered obvious by the count when taken in view of Kim and Nesbitt.

The count discloses everything therein except for the inner layer having a diameter of 20.0 to 29.0 mm, the intermediate layer and the inner layer having a combined diameter of 35.0 to 39.5 mm, and the outer layer, the inner layer, and the intermediate layer having a combined diameter of 37.5 to 41.0 mm.

Kim teaches a multilayer golf ball having an inner core (corresponding to the claimed inner layer) with a diameter of 23-35 mm, an outer layer 2 diameter (corresponding to the combined inner layer and intermediate layer diameter, as claimed) having a value of 36-41 mm. The lower end point of each of these ranges falls within the claimed diameter ranges. Further, Kim teaches that if the diameter of the inner core is less than 23 mm, the diameter of the soft outer layer has to be increased and rebound characteristics are adversely affected. On the other hand, if the diameter of the inner core exceeds 35 mm, the diameter of the outer layer has to be decreased, and feeling would be adversely affected due to the hard inner core. See Kim at col. 2, lines 41-49. Moreover, Kim teaches that if the diameter of the combined core and outer layer is less than 36 mm, the carry distance will be decreased due to the increased thickness of the cover. See Kim at col. 2, lines 58-64.

Accordingly, one of ordinary skill in the art would have been motivated to modify the count so as to have an inner layer having a diameter of 23 mm and a combined inner layer and intermediate layer diameter of 36 mm, so as to avoid adversely affecting feeling of the golf ball, as well as to avoid decreasing the carry distance, as taught by Kim.

Nesbitt teaches a multi-layer golf ball having a two-piece cover, wherein the inner cover layer has a thickness of .020 to .070 inches (corresponding to .508 to 1.778 mm). See, for example, abstract, Fig. 2, and col. 3, lines 16-25. Additionally, Nesbitt teaches that the advantage of his two piece cover construction is that it provides a golf ball in which the

coefficient of restitution of the golf ball closely approaches or attains that which provides the maximum initial velocity permitted by the USGA rules of 250 ft/sec, while also maintaining advantageous "feel". See Nesbitt at: col. 1, line 65 - col. 2, line 9; col. 2, lines 59-65; and col. 3, lines 34-44.

Accordingly, one of ordinary skill in the art would have been motivated to modify the cover of Kim so as to provide a two-piece cover as taught by Nesbitt so as to achieve a coefficient of restitution that provides the maximum initial permitted velocity while maintaining a good "feel". In so modifying Kim, one of ordinary skill in the art would have been taught (for the above-noted reasons presented in Nesbitt) to provide an inner cover (corresponding to the claimed outer layer) having a thickness of .508 to 1.778 mm. Adding twice the thickness of the inner cover (so as to find the combined diameter of three layers) to the combined diameter (core and layer covering the core) of Kim's golf ball gives a value of:

$$(\text{core} + \text{intermediate layer} + \text{outer layer}) = 36 \text{ mm} + (2 \times 1.778 \text{ mm})$$

$$= 39.556 \text{ mm, which falls within the claimed range of the outer layer, the inner layer, and the intermediate layer having a combined diameter of 37.5 to 41.0 mm.}$$

Claim 4 of the Ohsumi patent (claim 16 of the Yamagishi Application) is rendered obvious by the count when taken in view of Kim and Yamada.

The count discloses everything therein except for a weight distribution in the solid core being designed so that the inner layer has a large specific gravity, and the intermediate layer and the outer layer have specific gravities which are smaller than the specific gravity of the inner layer.

Kim teaches a multilayer golf ball having an inner core with a specific gravity greater than that of an outer layer so as to provide adequate spin thereby allowing an optimum trajectory

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and a superior carry distance. See Kim at col. 3, lines 26-35, 51-53. Similarly, Yamada teaches that in a multi-layer golf ball, the specific gravity of the core is made high in order to reduce the moment of inertia for making spinning frequency as high as wound balls to gain a hopping trajectory and improving the controllability of the ball. See Yamada at: col. 1, lines 29-32, 47-54; col. 2, lines 14-22; col. 2, lines 59-67; and col. 5, lines 11-17.

Accordingly, one of ordinary skill in the art would have been motivated to modify the count so as to make the core with a specific gravity higher than the layers covering it (i.e., each of the claimed intermediate and outer layers) so as to provide a high spinning frequency to gain a hopping trajectory and improve controllability of the ball, as taught by Kim and Yamada.

Claim 5 of the Ohsumi patent (claim 17 of the Yamagishi Application) is rendered obvious by the count when taken in view of any one of Cavallaro, Kim, or Yamada.

The count discloses everything therein except for the solid core being formed by using a rubber composition comprising a base material composed of natural and/or synthetic rubber.

Each one of Cavallaro, Kim, and Yamada, teaches that it is conventional to use a solid core of rubber composition. See, for example: Cavallaro at col. 2, lines 5-17, (“... golf ball has a center portion and the outer layer [corresponding to the claimed intermediate layer] formed from a rubber composition ...” (citing to USP 4,863,167)); Cavallaro at col. 2, lines 37-47, (“... golf ball having a center and outer layer [corresponding to the claimed intermediate layer] which are prepared from a rubber composition ...” (citing to USP 5,072,944)); Cavallaro at col. 5, lines 26-31 (“[t]he core of the present invention may comprise a variety of materials, including those conventionally employed as golf ball cores ... includ[ing] natural or synthetic rubbers.”); Kim at col. 3, line 65 - col. 4, line 2 (“The inner core and the outer layer [corresponding to the claimed intermediate layer] comprises a rubber base ... As a base rubber ... natural rubber ... may be optionally added to 1,4-polybutadiene.”); and Yamada at col. 1, lines 45-65 (“the core ... can be

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easily obtained from a rubber composition which is prepared according to formulations of conventional core compositions for two piece solid golf ball ...").

Accordingly, one of ordinary skill in the art would have been motivated to modify the count so as to include a core made of a rubber, as is conventional in the golf ball art, as evidenced by Cavallaro, Kim, and Yamada.

Claim 6 of the Ohsumi patent (claim 18 of the Yamagishi Application) is rendered obvious by the count when taken in view of either Cavallaro or Viollaz.

The count discloses everything therein except for the at least one layer of said solid core being formed by using a material comprising one selected from ionomer resins and thermoplastic resins.

Each Cavallaro and Viollaz teaches a multilayer golf ball having a solid core, wherein at least one of the layers of the solid core is formed using an ionomer or thermoplastic resin. See, for example: Cavallaro at col. 3, lines 5-20 (citing to USP 5,253,871 as having a core of thermoplastic material, citing USP 4,431,193 as having an ionomer resin inner layer, and citing USP 5,314,187 as having an ionomer resin inner layer); Cavallaro at col. 3, lines 31-44 (present invention has a core with one or more layers, wherein one of those layers is made of dynamically vulcanized thermoplastic elastomer, thermoplastic polyurethane.); Cavallaro at col. 3, line 66 - col. 5, line 5 (describing suitable thermoplastics for one of the layers of a solid core of a multilayer golf ball); Viollaz at col. 2, lines 56-60 (multilayer golf ball having an intermediate layer of thermoplastic copolymer of amide block polyether); Viollaz at col. 3, lines 18-27 (explaining the benefits of adding an ionomer resin to the intermediate layer of the solid core).

Accordingly, one of ordinary skill in the art would have been motivated to modify the count so as to provide a multilayer golf ball wherein at least one layer of the solid core is formed by using a material comprising one selected from ionomer resins and thermoplastic resins, as is conventional in the art, as evidenced by Cavallaro and Viollaz.

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Claim 7 of the Ohsumi patent (claim 19 of the Yamagishi Application) is rendered obvious by the count when taken in view of any one of Cavallaro, Sun, Viollaz, Kim, Yamada, and Nesbitt.

The count discloses everything therein except for the cover being formed by using an ionomer resin or a material containing it.

Cavallaro, Sun, Viollaz, Kim, Yamada, and Nesbitt, teach that in the golf ball art, an ionomer resin is conventionally used for the cover of the golf ball. See, for example: Cavallaro at col. 1, lines 31-33; Cavallaro at col. 3, lines 10-16, citing Nesbitt; Cavallaro at col. 5, line 66 - col. 6, line 49 (preferred conventional cover materials are ionomer resins); Sun at col. 3, lines 33-47; Viollaz at col. 4, lines 4-21; Kim at col. 6, lines 35-38; Yamada at col. 1, line 66 - col. 2, line 14; and Nesbitt at col. 1, lines 57-64.

Accordingly, one of ordinary skill in the art would have found it obvious to modify the count to as to include a cover made of ionomer resin material, as is preferred and conventional in the golf ball art, as evidenced by Cavallaro, Sun, Viollaz, Kim, Yamada, and Nesbitt.

Conclusion

In light of the above discussion, claims 1-7 of the Ohsumi patent correspond to the proposed count. Further, as also noted above, claims 13-19 of the Yamagishi application correspond to the proposed count.

III. Claim Comparison §41.202(a)(3)

As set forth in §41.203(a), an interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa. Please see the chart as set forth in Appendix A, explaining how the claims interfere with each other.

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Additionally, Applicants offer the following comments as to how the claimed subject matter as set forth in the Yamagishi Application interferes with the subject matter of the Ohsumi patent.

The Yamagishi Application is directed to a multi-piece solid golf ball having a structure of at least four layers, as shown in Figure 2. The golf ball includes a core having a structure including at least two layers, referred to in the disclosure as an inner sphere 12 and layer 13 that surrounds the inner sphere 12, and a cover for enclosing the core. The cover has an inner cover layer 15 and outer cover layer 16. The outer cover layer 16 has a hardness in the range of 40 to 60 Shore D, and the inner cover layer has a hardness of up to 53 Shore D and is lower than the hardness of the outer layer 16.

Similarly, the Ohsumi Patent discloses and claims a four-piece (“multi-piece”), solid golf ball having a core including an inner layer 12a, intermediate layer 12b, outer layer 12c, and a cover 14 for covering the core, as seen in the lone figure of the Ohsumi Patent. As disclosed in the Ohsumi patent, the Shore D hardness of the layers 12a and 12b fall within the range of 15-40 and 45-65, respectively, while the Shore D hardness of the layer 12c is less than the layer 12b and is less than the cover 14, which has a hardness of 68 Shore D.

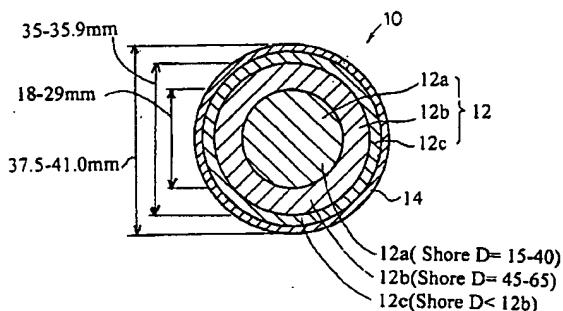
The layers of the golf ball disclosed and claimed in the Ohsumi Patent corresponds to the layers of the golf ball disclosed and claimed in the Yamagishi Application as follows:

Ohsumi Patent	Yamagishi Application
Inner layer 12a	Inner sphere 12
Intermediate layer 12b	Layer 13
Outer layer 12c	Inner cover layer 15
Cover 14	Outer cover layer 16

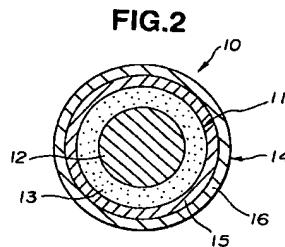
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For ease of reference, the relevant figures from the Ohsumi Patent (left) and the Yamagishi Application (right) are reproduced below.



Ohsumi Patent



Yamagishi Application

The Ohsumi Patent characterizes the layers 12a, 12b, 12c as part of the core, and refers to the core as composed of a three-layered structure. Ohsumi Patent, col. 2:30-33; 2:37-38; 2:48-50. On the other hand, the Yamagishi Application refers to the core as including two layers 12, 13 and the cover as including two layers 15, 16. Applicants submit that there is no difference in the layer 12c of the Ohsumi Patent, which is characterized as part of the core, and the inner cover layer 15 of the Yamagishi Application, which is characterized as part of the cover. Both layers are the third layer counting from inside out and, conversely, both layers are the second layers counting from outside in.

Moreover, both layers may be composed of similar materials such as an ionomer resin,² as opposed to a rubber base material which is the typical composition of a core layer. Both layers have similar compositions. For example, the Ohsumi Patent states that the layers making

² Compare Ohsumi Patent, col. 2:48-55 and Table 1, Example 5 with Yamagishi Application, page 6, lines 26-29.

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up the core may be formed of a rubber composition composed of a base material of natural and/or synthetic rubber, or may be formed using a material comprising an ionomer resin and/or a thermoplastic elastomer such as those composed of styrene, olefin, urethane, ester, and amide. The Ohsumi '816 patent, col. 2:48-55. Table 1 lists five examples where the layers of the core vary. In Example 5, the outer layer 12c is composed of a thermoplastic polyamide elastomer and Himilan 1605 (i.e., an ionomer resin). In the Yamagishi Application, the surrounding layer 13 may be formed of an ionomer resin or thermoplastic resin (e.g., Himilan which is an ionomer resin or Hytrel which is a polyester elastomer) (pages 7 and 10) and the inner cover layer 15 may be composed of an ionomer resin. Page 6, lines 26-29.

Claims 13-19 of the Yamagishi Application were copied substantially verbatim from the Ohsumi Patent, claims 1-7. In particular, claims 13 and 16-17 and 19 were copied identically, while claims 14-15 and 18 vary slightly. The range of hardness (claim 14) and diameter (claim 15) of the "inner layer," and composition of one of the inner layers (claim 18) are slightly different so that the copied claims are supported by the disclosure of the Yamagishi Application. These differences are insubstantial. The hardness described in the Yamagishi Application ranges from 20 to 40, while in Ohsumi Patent the hardness ranges from 15 to 40. The diameter of the inner layer is defined in the Yamagishi Application as ranging from 20 mm to 39 mm, while in Ohsumi Patent the diameter ranges from 18 to 29 mm. The composition of the surrounding layer 13 (i.e., one of the layers of the "core") may be of an ionomer resin or thermoplastic resin. Specific examples include Himilan (an ionomer resin) and Hytrel (a polyester elastomer).

IV. § 41.202(a)(4) - Why Yamagishi Should Prevail on Priority

A. The Yamagishi Application has an earlier effective filing date than does the Ohsumi Patent

As noted below, the Yamagishi Application is entitled to an effective filing date of June 14, 1995, whereas at best the Ohsumi Patent would be entitled to an effective filing date of April 1, 1996.

It should be determined that Yamagishi et al's Japanese priority document was filed prior to the March 27, 1997, filing date of the application which matured into the Ohsumi Patent. In particular, Yamagishi et al's Japanese priority document was filed June 14, 1995. This date is prior to the March 27, 1997, filing date of the application which matured into the Ohsumi Patent, as well as prior to the April 1, 1996, filing date of Ohsumi's Japanese priority document.

Accordingly, in any Interference declared between the Yamagishi Application and the Ohsumi Patent, Yamagishi et al should be designated the Senior Party and Ohsumi et al should be designated the Junior Party.

B. The Yamagishi Application

Claims 13-19 of the Yamagishi Application were presented in the Amendment filed April 27, 1999. That is, Claims 13-19 were added to the Yamagishi Application less than one year after the issuance of the Ohsumi Patent on April 28, 1998.

The Yamagishi Application is a Rule 60 Continuation of Yamagishi Parent Application Serial No. 08/661,775, filed June 13, 1996 (now U.S. Patent 5,688,595).

Yamagishi et al. claim benefit of priority under 35 U.S.C. § 120 to Yamagishi Parent Application Serial No. 08/661,778, filed June 13, 1996.

As discussed in detail in the Preliminary Amendment filed July 25, 1997, the Amendment filed July 25, 1997, and the Amendment filed October 28, 1998, Claims 13-19 are

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supported in the Yamagishi Application. Claims 13-19 were added subsequent to the original filing. However, support for Claims 13-19 of the Yamagishi Application can be found in Appendix B, attached hereto.

Furthermore, the Yamagishi Application is a Rule 60 Continuation of Yamagishi Parent Application Serial No. 8/661,778, filed June 13, 1996. Thus, identical support for Claims 13-19 can be found in the Yamagishi Parent Application. Again, please see Appendix B.

Accordingly, in any Interference declared between the Yamagishi Application and the Ohsumi Patent, Claims 13-19 of the Yamagishi Application should be accorded benefit under 35 U.S.C. § 120 to the June 13, 1996, filing date of Yamagishi Parent Application Serial No. 08/661,778.

Furthermore, Yamagishi et al. claim benefit of priority under 35 U.S.C. § 119 to JPA 7-171520, filed June 14, 1995. Support in sworn English translation of JPA 7-171520 for claims 13-19 of the Yamagishi Application can be found in the claim chart in Appendix C, attached hereto.

A certified copy of JPA 7-171520 was filed on June 13, 1996, in the Yamagishi Parent Application. Acknowledgement of receipt of said certified copy of the JPA 7-171520 can be found on page 1 of the Office Action dated May 29, 1998 in the Yamagishi Application. Moreover, on February 29, 2000, with the original Request for Interference, Yamagishi et al. submitted a sworn translation into English of JPA 7-171520.

Hence, Claims 13-19 of the Yamagishi Application are fully supported, in accordance with 35 U.S.C. § 112, in JPA 7-171520, filed June 14, 1995.

Accordingly, in any Interference declared between the Yamagishi Application and the Ohsumi Patent, Claims 1-19 of the Yamagishi Application should be accorded benefit under 35 U.S.C. § 119 to the June 14, 1995, filing date of JPA 7-171520.

C. The Ohsumi Patent

As discussed above, the filing date of the application which matured into the Ohsumi Patent is March 27, 1997. The Ohsumi Patent does not claim benefit of priority under 35 U.S.C. § 120 to any earlier filed U.S. application.

The Ohsumi Patent claims benefit of priority under 35 U.S.C. § 119 to JPA 8-079203, filed April 1, 1996. However, a sworn translation into English of JPA 8-079203 copy is not of record in the file history of the Ohsumi Patent. Thus, at least at this point in time, Ohsumi et al is not entitled to benefit of priority under 35 U.S.C. § 119.

V. § 41.202(a)(5) - Written Description

Appendix B sets forth a claim chart showing the written description for each of claims 13-19 in the specification as originally filed. Additionally, the claim chart in Appendix B sets forth where claims 13-19 are supported by parent application 08/661,778 (the recitations matching those for the specification as originally filed in the present application, because the present application was a Rule 60 (i.e., true copy) Continuation of the '778 parent application).

VI. § 41.202(a)(6) - Constructive Reduction to Practice

Appendix C sets forth a claim chart showing where the disclosure provides a constructive reduction to practice, by Applicant's Japanese priority document 07-171520, within the scope of the interfering subject matter. References in the claim chart of Appendix C are made to the Verified English translation of the priority document as filed on February 29, 2000.

Additionally, as noted above, Appendix B sets forth a claim chart showing where the parent '778 application provides support for claims 13-19 of the Yamagishi Application.

VII. § 41.202(d)(1)

This section does not apply to the current situation.

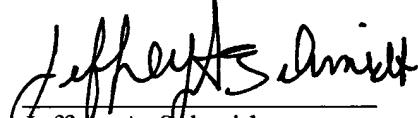
NEW REQUEST FOR INTERFERENCE PURSUANT TO 37 C.F.R. § 41.202
WITH U.S. PATENT 5,743,816
U.S. Application No. 08/898,853

Atty. Docket: Q45980

VIII. Conclusion

The Examiner is invited to contact the undersigned at his Washington telephone number on any questions which might arise.

Respectfully submitted,



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